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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,663	02/03/2005	Keiji Otaki	122381	9411
25944	7590	09/12/2007		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER O HERN, BRENT T	
			ART UNIT 1772	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/520,663

Applicant(s)

OTAKI ET AL.

Examiner

Brent T. O'Hern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 August 2007 has been entered.

### *Claims*

2. Claims 1, 3-7, 9 and 11-16 are pending.

## WITHDRAWN REJECTIONS

4. The 35 USC 102(b) rejections of claims 1-6 and 9-11 as being anticipated by Botsolas (US 4,054,710), of record in the Office Action mailed 12 April 2007, page 2, paragraph 6, are withdrawn due to Applicant's amendments in the Paper filed 12 July 2007.

5. The 35 USC 103(a) rejections of claims 7 and 12-16 as being unpatentable over Botsolas (US 4,054,710) in view of Berdan, II (US 5,350,063), of record in the Office Action mailed 12 April 2007, page 4, paragraph 7, are withdrawn due to Applicant's amendments in the Paper filed 12 July 2007.

## NEW REJECTIONS

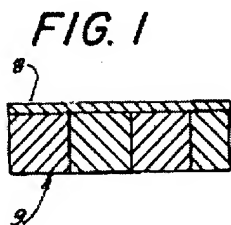
### *Claim Rejections - 35 USC § 102*

6. Claims 1, 3-6, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Botsolas (US 4,054,710).

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Regarding claim 1, Botsolas ('710) teaches a mat-shaped thermal insulator made of inorganic fiber (See col. 3, ll. 8-15 and FIG-1.), wherein at least a part of inorganic fibers is built-up in a direction parallel to lateral surfaces of the insulator (See col. 3, ll. 26-55.), and the insulator has a density of about 10-32 kg/m<sup>3</sup> /(0.62-1.99 lb/ft<sup>3</sup>) (See col. 3, ll. 16-20.),

the lateral surfaces of the insulator are inclined (See FIGs 1 and 2 and col. 3, ll. 44-55 wherein the lateral surfaces are inclined by approximately 90 degrees relative to the horizontal axis.).

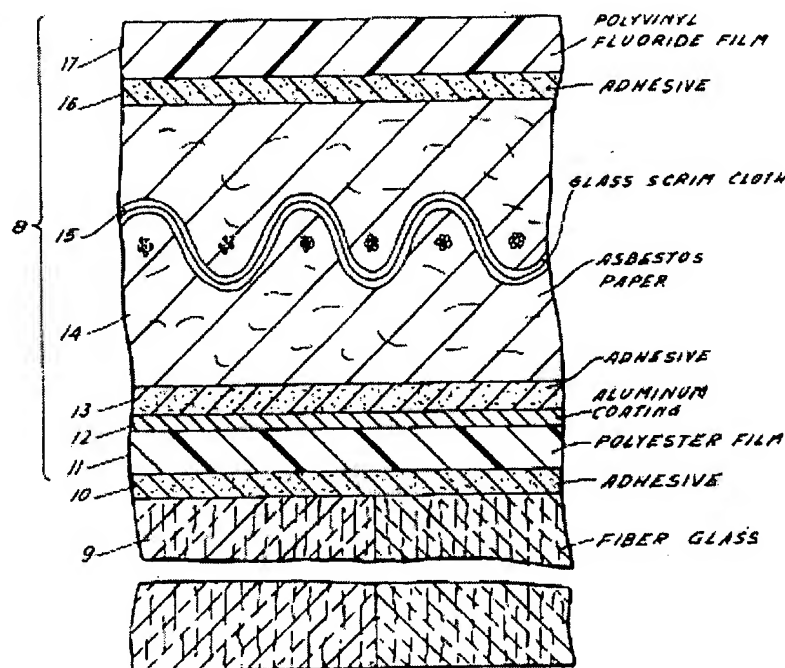


The phrase **“said insulator is formed by cutting a fibrous built-up article formed by building-up inorganic fibers, to form cut built-up articles, rotating at least one of the cut articles by an angle of 90 degrees in a direction perpendicular to a longitudinal direction, to form a rotated built-up article in which the inorganic fibers are built-up in a direction parallel to lateral sides of the cut article, and integrating the cut articles and/or the rotated article transversally in a direction perpendicular to the longitudinal direction”** in claim 1, lines 7-14 and claim 3, lines 9-16 are **process limitations** in product claims and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

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Regarding claims 3 and 9, Botsolas ('710) teaches a mat-shaped thermal insulator made of inorganic fiber (See col. 3, ll. 8-15 and FIG-1.), wherein at least a part of inorganic fibers is built-up in a direction parallel to lateral surfaces of the insulator (See col. 3, ll. 26-55.), the insulator has a density of about 10-32 kg/m<sup>3</sup> /(0.62-1.99 lb/ft<sup>3</sup>) (See col. 3, ll. 16-20.),

the insulator is provided with longitudinal cuts on the lateral surfaces of the insulator (See col. 3, ll. 18-24 and FIG-1, vertical cuts.).

**FIG. 2**

The phrase “so as to make the insulator partially compressible” in claims 3 and 9, lines 8 and 3, respectively, are deemed to be statements with regard to the **intended use** and are not further limiting in so far as the structure is concerned (see MPEP 2111.02).

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Regarding claims 4 and 11, Cameron Botsolas ('710) teaches an insulator wherein at least one of the surfaces of the insulator is coated by a facing material (See *FIG-1, #8 and col. 2, ll. 40-48.*).

Regarding claims 5-6, Botsolas ('710) teaches an insulator wherein the insulator and the facing material are bonded to each other by means of an adhesive agent (See *FIG-2, #10.*).

***Claim Rejections - 35 USC § 103***

7. Claims 7 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botsolas (US 4,054,710) in view of Berdan, II (US 5,350,063).

Botsolas ('710) teaches wherein each of the mat-shaped inorganic fiber thermal insulators, inorganic fibers are built-up in a direction of a width of the aligned article (See *FIG-1, width of #9.*), however, fails to expressly disclose a package and wherein the package comprises a packaging bag.

However, Berdan, ('063) teaches a package and wherein the package comprises a packaging bag (See *col. 1, ll. 18-20 and FIG-8.*) for the purpose of reducing transportation costs (See *col. 1, ll. 14-18.*).

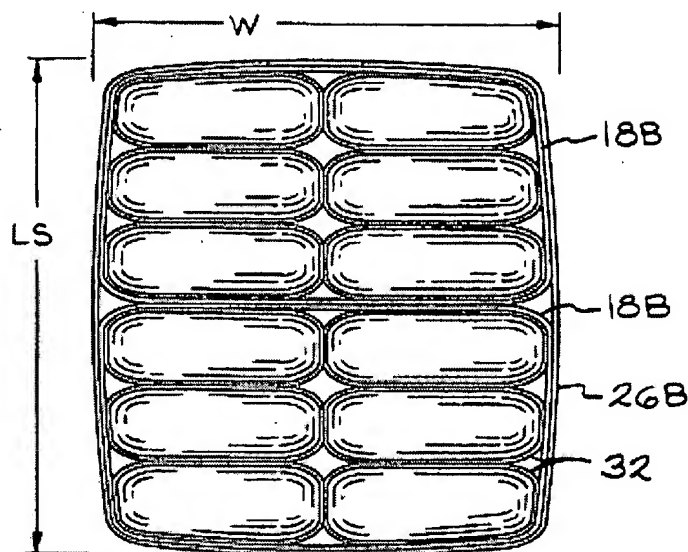


FIG. 8

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicants' invention was made to modify Botsolas' ('710) insulator with a packaging bag as taught by Berdan, ('063) in order to provide a packaged article with reduced transportation costs.

The phrases **"said aligned articles are compressed transversally, said aligned articles are formed by arranging a plurality of mat-shaped inorganic fiber thermal insulators according to claim ... in parallel and/or by laying the insulators one on the other"** in claims 7 and 12-16, lines 4-8 of all claims are **process limitations** in product claims and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

#### ANSWERS TO APPLICANT'S ARGUMENTS

8. In response to Applicant's argument (*p. 7, paras. 3-6 of Applicant's Paper filed 12 July 2007*) that Botsolas ('710) does not teach wherein the lateral surfaces are inclined,

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it is noted as discussed above that Botsolas ('710) teaches wherein the lateral surfaces of the insulator are inclined by approximately 90 degrees relative to the horizontal axis (*See FIGs 1 and 2 and col. 3, ll. 44-55.*).

9. In response to Applicant's argument (*p. 7, para. 7 to p. 8, para. 1 of Applicant's Paper filed 12 July 2007*) that Botsolas ('710) does not teach wherein the insulator is partially compressible and the cuts are longitudinal per claim #3, it is noted that Botsolas ('710) is clearly compressible and the cuts are longitudinal and Applicant does not limit a vertical element to the cuts (*See FIG-2.*).

10. In response to Applicant's argument (*p. 8, paras. 3-5 of Applicant's Paper filed 12 July 2007*) regarding the 35 USC 103 rejections it is noted that Applicant has not presented any further arguments than already discussed.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-Th, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brent T O'Hern  
Examiner  
Art Unit 1772  
September 5, 2007



NASSER AHMAD 9/10/07  
PRIMARY EXAMINER